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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,296	11/30/2000	Henry N. Holtzman	PRT-007	4729

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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

44

**Office Action Summary**

Application No.

09/726,296

Applicant(s)

HOLTZMAN ET AL.

Examiner

Lalita M Hamilton

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement (IDS)***

The file indicates that IDSs were submitted on November 11, 2000, February 20, 2001, and January 22, 2001. However, the Examiner was not able to locate the IDSs in the file nor were they available in IFW. The Examiner respectfully request that the Applicant resubmit all IDSs for consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-8, 10-15, 17-19, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Withrow (6,116,505).

Withrow discloses a fuel transaction method and corresponding system for enabling purchases comprising completing a form presented to a user in a computer application program, the form requesting information about the user, identifying a form presented to a user in a computer application program, the form requesting information about the user, receiving a magnetic stripe card comprising card information, generating a unique identifier based on the card information, associating the unique identifier with the user, obtaining user information based on the identifier, matching elements of user

information with elements of information about the user requested in the form, and completing the form request for information with the matching elements of user information (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65—user fills in form using data on card and by making selections); the steps are performed in response to a single user action, the single user action comprising directing a magnetic stripe card through a magnetic stripe reader (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); the magnetic stripe card is received by a reader comprising a magnetic stripe card reader and an RFID token reader (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); the unique identifier is generated by providing the card information as input to a one-way function (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); the unique identifier is generated by combining elements of card information, and providing the combined card information as input to a one-way function (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); the user information is at least a portion of a user profile obtained from a server accessible via the internet (col.9, lines 20-50); the user information is obtained from a local database (col.9, lines 20-50); completing the request for information with at least one element of card information and with matching elements of user information (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); elements of user information are matched with elements of information about the user requested in the form by matching form field names with elements of user information (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); and identifying a form in a web page downloaded from a merchant web server presented to a user in a web browser,

associating by an information server separate from the merchant web server the unique identifier with the user, obtaining by the merchant web server directly from the information server user information based on the identifier, and completing by the merchant web server the form request by matching elements of user information with the requested information (col.1, line 64 to col.2, line 20; col.6, lines 5-53; col.7, lines 20-65; and col.9, lines 20-50—user may elect to purchase merchandise from merchant using internet interface).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withrow in view of Klein (6,178,426).

Withrow discloses the invention substantially as claimed; however, Withrow does not disclose the form being identified by parsing the HTML code or elements of user

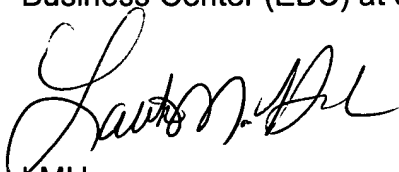
information are matched with elements of information about the user requested in the form by using a field mapping script. Klein teaches a method and corresponding system with extended markup language data and capture capability comprising the form being identified by parsing the HTML code (col.10, lines 1-20) and elements of user information are matched with elements of information about the user requested in the form by using a field mapping script (col.10, lines 1-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the form being identified by parsing the HTML code and elements of user information are matched with elements of information about the user requested in the form by using a field mapping script, as taught by Klein into the invention disclosed by Withrow, to aid the user in completing forms when utilizing internet capability.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH